



Paper No. 4

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JUL 19 2001

**OFFICE OF PETITIONS
A/C PATENTS**

IP Administration
Legal Department, 20BN
Hewlett-Packard Company
P.O. Box 10301
Palo Alto, California 94303-0890

In re Application of
Thompson, Santhanam, Ju, and Bala
Application No. 09/814,511
Filed: March 22, 2001
Attorney Docket No. 10961404-1
For: METHOD AND APPARATUS FOR ORDERED
PREDICATE PHI IN STATIC SINGLE ASSIGNMENT
FORM

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: DECISION REFUSING STATUS
: UNDER 37 CFR 1.47(a)
:
:
:

This is a decision on the petition under 37 CFR 1.47(a), filed June 5, 2001.

The petition under 37 CFR 1.47(a) is **dismissed**.

Any request for reconsideration under this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. Any response should be titled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)." Failure to respond will result in abandonment of the application. Extensions of time are available and will be governed by 37 CFR 1.136(a).

This above-cited application became abandoned for failure to respond in an appropriate and timely manner to the "Notice to File Missing Parts of Nonprovisional Application" (the "Notice"), mailed April 30, 2001, which indicated that a signed oath or declaration was missing and also that a surcharge of \$130.00 was due, consequently. The Notice also advised that the filing fees in the amount of \$710.00 had not been remitted. The Notice set forth an extendable period for reply of two months. On June 5, 2001, in response to the Notice, petitioner filed the instant petition, a declaration of relevant facts, a "Combined Declaration for Patent Application and Power of Attorney", and other supporting documentation. Petitioner also remitted the \$130.00 surcharge.

A grantable petition under 37 CFR 147(a) requires:

- (1) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims, and drawings);
- (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116;
- (3) the petition fee; and,
- (4) a statement of the last known address of the non-signing inventor.

With respect to non-signing inventor Ju, the instant petition lacks item (1).

As to item (1), petitioner has not demonstrated that petitioner made a 'diligent' effort to locate inventor Dz-Ching Ju. Section 409.03(d) of the MPEP requires that a showing of diligence be made in petitioner's efforts to locate a non-signing inventor before a refusal to join application will be assumed. The requisite showing of diligence is not demonstrated by the instant petition. There is no indication that petitioner attempted to search any available databases, i.e. National Registries, telephone books, the Internet, to locate inventor Ju. Although petitioner indicates that "diligent" efforts were used to locate the non-signing

inventor, petitioner did not detail such efforts in the instant petition. Section 409.03(d) of the MPEP reads, in pertinent part, that "[w]here inability to find or reach a nonsigning inventor after diligent effort is the reason for filing under 37 CFR 1.47, an affidavit or declaration of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made." Petitioner provided no such recitation of petitioner's alleged efforts and without the aforementioned the Office cannot determine whether the diligence requirement has been met.

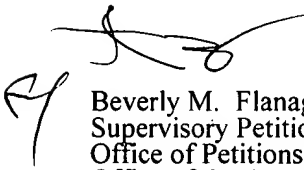
Further correspondence with respect to this matter should be addressed as follows:

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